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| 909 7590 12/08/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102 | | | EXAMINER CAMPEN, KELLY SCAGGS | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/732,008
Filing Date: December 08, 2000
Appellant(s): ROBB, PAUL H.

Syed Jafar Ali
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/11/2007 appealing from the Office action mailed 03/09/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Copending U.S. application number 09/877,926 is a related appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 39-41 are now rejected under 35 USC 101.

NEW GROUND(S) OF REJECTION

Claims 1-12 are rejected under 35 USC 101 for the claimed invention being nonstatutory.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief. Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of copending Application No. 09/877,926. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

A "forum" encompasses a "collaboration tool", "defining a scope of authorization" encompasses "encryption", and a "library of resources" encompasses a "database".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Although the appellant disagrees with the provisional double-patenting rejections set forth by the Examiner, the Appellant did not address these provisional rejections in the Appeal Brief. Rather, the appellant states the appellant will file a terminal disclaimer upon the indication of allowable subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|-------------------|---------|
| 5,940,843 | Zucknovich et al. | 08-1999 |
| 6,243,722 | Day et al. | 06-2001 |

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not provide any transformation nor do they have any other statutory class in the body of the claim. The mere recitation of another statutory class in the preamble in the absence of a recitation of another statutory class in the body of a claim does not render a claim statutory. The claims recite a method including the steps of providing and multiple enabling steps. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the independent claims there is recited terms that are indefinite because there is no clear definition of the meets and bounds of the term. There terms include: “collaborate”, “enabling”, and “to interact”.

In dependant claims there is recited: “events” and “actions” which are also terms that are indefinite because there is no clear definition of the meets and bounds of the term.

The terms “client” and “participants” are confusing since the relationship between the two is not recited (i.e.: are the participants clients of the client?).

All claims will be examined as best understood.

All dependant claims that are not vague and indefinite are rejected because they encompass a rejected independent claim.

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Claims 20-38 recite "system" which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are considered apparatus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-17, 19-26, 28-36, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al.

Zucknovich et al discloses a method for providing a tool with which a client and one or more participants may interact. A client authorizes one or more participants to access client data (col 1, lines 50-56). The client submits client data to the tool (col 5,

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lines 60-67). The client submits one or more requests for one or more services to the tool (col 6, lines 25-30). The client interacts with one or more participants through the tool, wherein interaction among participants comprises exchange of client data (col 87, lines 14-50). The participants may be financial advisors (col 5, lines 55-56). The participants comprise one or more entities authorized by the client to participate in the tool, wherein the client also defines the scope of authorization for each participant (col 6, lines 25-30).

The client data comprises financial documents as a work product (col 2, lines 41-50). The client is enabled to define one or more triggering events / alert mechanisms for notifying the client of an occurrence (col 7, lines 32-37). There is enabled the client to access a client history database wherein the client history database maintains information related to previous updates (col 83, lines 26-45).

Zucknovich et al does not use the word “collaboration” to describe their tool.

It would have been obvious to one with ordinary skill in the art to include “collaboration” as describing the tool to Zucknovich et al because Zucknovich et al. teaches that research providers require interaction with those who desire their work product (col 1, lines 39-44).

Claims 8, 18, 27, 37, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al as applied to claims 1-7, 9-17, 19-26, 28-36, 38 above, and further in view of Day et al.

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Zucknovich et al does not disclose enabling the client to view participant input wherein participant input comprises one or more or edits, analysis and comments related to client data.

Day et al discloses disclose enabling the client to view participant input wherein participant input comprises one or more or edits, analysis and comments related to client data (col 3, lines 45-67; col 4, lines 1-25).

It would have been obvious to one with ordinary skill in the art to include participant input wherein participant input comprises one or more or edits, analysis and comments related to client data because Day et al teaches collaborative efforts require edits, analysis and comments (col 3, lines 45-64; col 4, lines 6-25), and Zucknovich et al teaches correction for inaccuracies of client data (col 1, lines 62-67; col 2, lines 1-25).

(10) Response to Argument

In response to appellant's argument against the 35 USC 112 second paragraph rejections, regarding "collaborate", "enabling", "to interact", "events", and "actions" these terms have relative meaning. What may be considered such to one may not be considered such to another. There are several 'participants' making the claims vague and overly broad in that it is unclear how the client differs and relates to each participant. In returning to the specification to clarify, the issue is made even more confusing as it appears that the terms 'client' and 'participant' are interchangeable. Additionally, appellant has not invoked 112 6th paragraph to assist in defining the terms and the metes and bounds of the invention claimed. Specifically as to appellant's argument on page 10 lines 14-18, appellant argues that it is "clear from the plain language of the claim" while

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the claim is unclear in that lines 2-3 of claim 1 refer to a financial services client and one or more financial services provider participants “ but lines 4-6 refer to “enabling authorization of one or more participants to access client data” and “ enabling a client or participant to submit client data. It is unclear if these participants and clients are financial clients and participants or they are additional to the financial clients and participants referred to in lines 2-3 of the claim. Examiner is using claim 1 as an example while the issue also exists in the remaining claims as well.

In response to that appellant's argument against the 112 2nd paragraph rejection to claims 20-38 as directed to a 'system', appellant has not identified which statutory class of invention the instant system claims would be directed merely arguing that a system claim is 'legal'. Regarding a system claim, since the term 'system' may encompass more than one statutory class, there is a requirement for an indication on the record as to what statutory class of invention the "system" claims belong to (see MPEP 2106.IV.B). The statutory provision for this requirement may be found in 35 U.S.C 101 that recites the statutory classes of invention.

Regarding the 35 U.S.C 103 rejection of record, the “interaction among the participants” and “an exchange of client data among the participants” is encompassed by what is disclosed by Zucknovich. Zucknovich discloses data exchange via the Internet or other network device to participants (researchers) and interaction in the form of discussing the research reports. The terms “interact” and “exchange” are given the broadest possible meaning.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that neither Zucknovich et al. nor Day et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Zucknovich et al. is both in the field of applicant's endeavor and is reasonably pertinent to the particular problem with which the applicant is concerned. Zucknovich et al. is concerned with distributing information to investors from a client. Day et al. is concerned with network based document (information) review tools via a computer network. Submitting information is analogous to submitting client data. Both involve an exchange of data.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

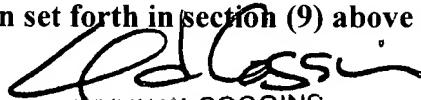
Respectfully submitted,

/Kelly Campen/

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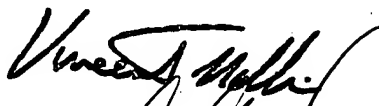
A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:



WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR

Conferees:

Vincent Millin



Alexander Kalinowski